



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,153	06/16/2005	Nobuaki Tanaka	38204	1383
53054 7590 07/23/2008 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108				
			EXAMINER	
			DABNEY, PHYLESHA LARVINIA	
			ART UNIT	PAPER NUMBER
			2614	
			NOTIFICATION DATE	DELIVERY MODE
			07/23/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patdocket@peame.com

dchervenak@peame.com

### Office Action Summary

**Application No.**

10/534,153

**Applicant(s)**

TANAKA ET AL.

**Examiner**

PHYLESHA L. DABNEY

**Art Unit**

2614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 5/13/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed has been entered.

This Action is in response the Amendment filed received on 5 May 2008 in which claims 1-2, 5-11, 13-17 are pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-2, 5, 9-11, 13, and 15-17** are rejected under 35 U.S.C. 102(e) as being anticipated Harano (U.S. Patent No. 7,082,322).

Regarding claim 1, 5, 15-17, Harano teaches a communication terminal including a circuit board having a ground plane, the circuit board (10) connected to an antenna (2, 7), and the circuit board contained in a casing, the communication terminal, comprising: a first conductive part (11-13, area of the structure), formed of a conductor, and provided in the casing so as to be exposed from a rear face of the casing; and a second conductive part (11-13, area of the

structure), formed of a conductor, and provided in the casing so as to be exposed from a bottom face or side face of the casing and a passive element (16) provided between the second conductive part and the ground plane of the circuit board, wherein the second conductive part is electrically connected to the ground plane of the circuit board through the passive element and to the first conductive part.

Regarding claim 2, Harano teaches the communication terminal as set forth in claim 1, further comprising a conductor fitting (15) which is provided between the second conductive part and the ground plane of the circuit board, wherein the second conductive part is electrically connected to the ground plane of the circuit board through the conductor fitting.

Regarding claims 9-11, 13, see the rejection of claims 1-2 and 5 respectively.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **6-8 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Harano in view of Toyota (U.S. Publication No. 2002/0160725 A1).

Regarding claim 6, Harano teaches a communication terminal including a circuit board (10) which is attached on a rear face side of a casing, the circuit board connected to an antenna

(2, 7), and the circuit board contained in the casing, the communication terminal, comprising: a conductive board (11-13, area of the structure), formed of a conductor, and arranged along a rear face of the casing; and a conductor part (11-13, area of the structure), formed of a conductor, and provided between the rear face of the casing and the circuit board,

Harano fails to teach the communication terminal having a shield case. However it is known in the art to surround the circuit board with a shield case to suppressing an electromagnetic interference between said printed circuit board and said antenna as evidenced by Toyoda (shield case: 4, 34; circuit board: 3, 33) and thus, have the conductor part electrically connected to the shield case and the conductive board as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a shield case in the invention of Harano as taught by Toyoda for the reason stated.

Regarding claim 7, the combination of Harano and Toyoda teaches the communication terminal as set forth in claim 6, wherein the conductive board (11-13, area of the structure) is arranged so as to be exposed from the rear face of the casing (figs. 6-8).

Regarding claim 8, the combination of Harano and Toyoda teaches the communication terminal as set forth in claim 6, wherein the conductive board and the conductor part are formed in one piece (11-13, area of the structure).

Regarding claim 14 which is dependent on claim 9, see the rejection of claim 6 above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHYLESHA L. DABNEY whose telephone number is (571)272-7494. The examiner can normally be reached on Mondays, Wednesdays, Fridays 8:30-4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**Any response to this action should be mailed to:**  
Commissioner of Patents and Trademarks  
P O Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**  
(703) 273-8300, for formal communications intended for entry and for informal or draft communications, please label "Proposed" or "Draft" when submitting an informal amendment.

**Hand-delivered responses should be brought to:**  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 15, 2008  
/Phylesha L Dabney/

Application/Control Number: 10/534,153

Page 6

Art Unit: 2614

Examiner, Art Unit 2614

/CURTIS KUNTZ/

Supervisory Patent Examiner, Art Unit 2614